

## Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed July 1, 2003. The fee for addition of new claims (or conversion of claims from dependent form to independent form) is included herewith.

Claims 90, 91, 93-96, 98-108 and 114-119 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected claims 90, 91, 95, 96, 98, 106, 108, 114 and 119, and allowed claims 93, 94, 99-105, 107 and 115-118. The present Response amends claims 90, 91, 95, 96, 98, 108, 114 and 119 and cancels claim 6 leaving for the Examiner's present consideration claims 90, 91, 93-96, 98-108 and 114-119. Reconsideration of the rejections is requested.

### I. REJECTION UNDER 35 U.S.C. §112

#### *Claim 106*

The Examiner rejected claim 106 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicants request cancellation of Claim 106.

### II. REJECTION UNDER 35 U.S.C. §102(E) OVER SAMANI (U.S. PAT. 5,645,599)

#### *Claims 95, 96, 98 and 114*

The Examiner rejected claims 95, 96, 98 and 114 under 35 U.S.C. §102(e) as being anticipated by *Samani*. The Applicants respectfully traverse this rejection.

The Examiner describes *Samani* as disclosing "an improved method...where the method includes introducing between the processes a device (15) or implant with flexible walls and shape memory and adapted

to absorb shock.” The Examiner further describes *Samani* as disclosing an “implant [that] assumes a second shape upon compression.”

Referring to Figures 5, *Samani* discloses “a bearing cushion 15 of suitable elastic material, either woven material or synthetic material.” See Col. 4, lines 44-48. Nowhere does *Samani* disclose a device “being adapted to receive and retain fluid” as recited in claims 95 and 96.

First, *Samani* fails to disclose a method comprising a device without rigid walls. Walls 5a and 5b are rigid.

Second, the cushion of *Samani* exhibits an elastic response, *resuming* a first shape once a compression force is removed. The cushion does not *assume* a second shape, but rather is *forced* to a shape other than a first shape by a deformation force. The cushion resumes (assumes again) the first shape once the deformation force is removed. *Samani* also does not change shape based on temperature.

Since *Samani* fails to disclose all of the features of claims 95, 96, 98 and 114, *Samani* cannot anticipate claims 95, 96, 98 and 114 under 35 U.S.C. §102(e). Accordingly, the Applicants respectfully request the withdrawal of this rejection.

### III. REJECTION UNDER 35 U.S.C. §102(E) OVER KRAPIVA (U.S. PAT. 5,645,597)

#### *Claims 108*

The Examiner rejected claim 108 under 35 U.S.C. §102(e) as being anticipated by *Krapiva*. The Applicants respectfully traverse this rejection.

The Examiner describes *Krapiva* as disclosing “a device (10), filled with gel and not connected to the spinous processes, which is able to dampen relative motion between spinous processes.” The Applicants submit that *Krapiva* does not disclose all of the features of claim 108 because *Krapiva* fails to disclose introducing a device “between adjacent spinous processes” as recited in claim 108 (Emphasis added). Referring to Figure 3, the method of *Krapiva* describes filling a space defined by an inner wall of a annulus fibrosis. Nowhere does *Krapiva* disclose introducing a device between adjacent spinous processes.

Since *Krapiva* fails to disclose all of the features of claim 108, *Krapiva* cannot anticipate claim 108 under 35 U.S.C. §102(e). Accordingly, the Applicants respectfully request the withdrawal of this rejection.

### IV. REJECTION UNDER 35 U.S.C. §103(A) OVER VOYDEVILLE (U.S. PAT. 5,609,634)

#### *Claims 90, 91 and 119*

The Examiner rejected claims 90, 91 and 119 under 35 U.S.C. §103(a) as being unpatentable over *Voydeville*. The Applicants respectfully traverse this rejection.

The Applicants submit *Voydeville* fails to teach or suggest an implant that is capable of self-conforming “to a contour of at least one of said spinous process and said another spinous process.” The ligament in *Voydeville* must be wound around the spinous process by the Doctor, requiring extensive access to the tissues of the patient. The present invention conforms without such intervention by the Doctor.

Since *Voydeville* fails to teach or suggest all of the features of claims 90, 91 and 119, and since *Voydeville* fails to teach or suggest an implant capable of being used in a manner teaching or suggesting all

of the features of claims 90, 91 and 119, *Voydeville* cannot render claims 90, 91 and 119 obvious under 35 U.S.C. §103(a). Accordingly, the Applicants respectfully request withdrawal of this rejection.

**V. ALLOWABLE SUBJECT MATTER**

***Claims 93, 94, 99, 100-105, 107 and 115-118***

The Applicants appreciate the indication that claims 93, 94, 99, 100-105, 107 and 115-118 are allowed. It is requested that the Examiner clarify the Reasons for Allowance to indicate that some claims are allowable as they are directed to devices that are fillable with a material and other claims are allowable as they have shape memory.

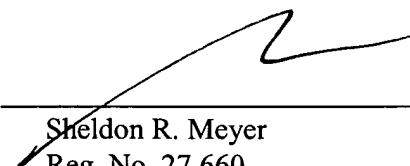
**VI. CONCLUSION**

In view of the above Remarks, reconsideration of claims 90, 91, 93-96, 98-108 and 114-119 is requested. It is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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